PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Confirmation No. 9944
	)	
CHOO *et al.*	)	Group Art Unit: 1648
	)	
Serial No.: 10/580,050	)	Examiner: TBA
	)	
I.A. Filed: November 19, 2004	)	Atty. Docket No. 51835-US-PCT

For: **METHODS AND REAGENTS FOR TREATING, PREVENTING, AND DIAGNOSING BUNYAVIRUS INFECTION**

PETITION UNDER 37 C.F.R. § 1.182 FOR DECISION ON A QUESTION NOT SPECIFICALLY PROVIDED FOR

U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

Applicants petition the Director under 37 C.F.R. § 1.182 to vacate the requirements to submit additional Large entity fees and to provide a copy of the Sequence Listing in computer readable form (37 CRF 1.821(e) for the application referenced above as set forth in the Notification of Defective Response mailed March 19, 2009. Please charge our Deposit Account No. 19-0733 for payment of the $400 fee for filing a petition under 37 CFR 1.17(f).

Statement of Facts

1. The present application (Serial No. 10/580,050) is a national phase application of PCT/US2004/039333 filed November 19, 2004. Serial No. 10/580,050 was filed by express mail on May 19, 2006.

2. A Notification of Missing Requirements requesting an executed declaration was mailed on January 16, 2007. The executed declaration was filed by express mail on August 10, 2007 together with payment for a five-month extension of time.

3. On January 31, 2008 Applicants filed by express mail a preliminary amendment and paper and computer readable forms of a sequence listing. The preliminary amendment inserted sequence identifiers into the specification and directed entry of the paper copy of the sequence listing into the specification.

4. On May 27, 2009, Applicants submitted a Petition for review and processing by the PCT legal office. The Petition included Exhibits providing evidence of full compliance with the Notification of Missing Requirements mailed January 16, 2007 and requesting withdrawal of the holding of Abandonment mailed May 14, 2009.

5. On July 1, 2009, Applicants filed by express mail a Response to the Notice of Abandonment providing a copy of the Notice of Abandonment, a Copy of the Notice to Comply with Requirement for Patents Containing Nucleotide or Amino Acid Sequence Disclosure, a Copy of the preliminary amendment submitted January 31, 2008 and March 20, 2009, and a paper and CRF copy of the Sequence Listing including statement under 37 CFR 1.82.

6. On July 28, 2009 a Decision on Petition under 37 CFR 1.181 was mailed. The Decision was granted and the Notification of Abandonment mailed May 14, 2009 was vacated.

7. On February 03, 2011 a Notice of Defective Response was mailed. The Notice asserted that a computer readable form of the sequence listing had not been submitted and that an additional supplemental $220 was required for additional claim fees. Further the Summary of Fees Due illustrated the total additional fees required is $220 for a Large Entity. A bullet point underneath this heading stated a copy of the Sequence Listing in CRF had not been submitted. The Notice provided a one-month initial deadline to respond (*i.e.*, until March 03, 2011) under 35 USC 371 or within the response set forth in a Notification of Missing Requirements, whichever is longer. The Notice also indicated that extensions of time were not available under 35 USC 371 however, extensions may be granted under 37 CFR 1.136(a) which was mailed February 18, 2009.

Point to be Reviewed

The point to be reviewed is whether the holding of the Notification of Defective Response should be withdrawn because it was applied in error after the Decision on Petition under 37 CFR 1.181 was granted vacating abandonment and confirming compliance with the sequence listing requirements.

Action Requested

Applicant requests that the Notification of Defective Response in this application be withdrawn and that any subsequent Notice of Abandonment immediately applied after said Notification of Defective Response be withheld and reconsidered.

Argument

The Notification of Defective Response appears to have been issued in error. As an initial matter, the Decision on Petition mailed July 28, 2009 confirmed Applicants had been in compliance with Sequence Listing requirements as early as January 31, 2008.

Moreover, the Notice of Defective Response itself was erroneously issued. In addition to the alleged lack of compliance with the Sequence Listing, fees are requested for additional claims ($220 as a non small entity) and for a Large Entity ($220). Throughout prosecution of this application, Applicants have authorized the Commissioner to charge any deficiency in fees which may be required under 37 CFR 1.16 and 1.17 to our Deposit Account 03-1664.

In order to understand the requirement of additional fees, Applicant compared its calculations, claim count and payment with the Patent Application Fee Determination Record mailed February 3, 2011. Applicants have identified that a $220 fee may have been required for its error in calculating the number of independent claims (1 claim was not paid). Applicants have always relied on its statement authorizing the Commissioner to charge for any deficiencies and have requested it repeatedly in the instant prosecution. Nevertheless, the deficiency of $220 was never applied despite Applicants' instructions and should be charged to our Deposit Account if applicable.

Applicants respectfully request that any holding of abandonment of this application be reconsidered and that the Notice of Defective Response be vacated.

Respectfully submitted,

NOVARTIS ACCINES AND DIAGNOSTICS INC

Date: March 09, 2011

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